

REMARKS

This is intended as a full and complete response to the Office Action dated January 31, 2007, having a shortened statutory period for response set to expire on April 30, 2007. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-26 are pending in the application. Claims 1-26 remain pending following entry of this response.

Claim Rejections - 35 U.S.C. § 102

Claims 1-7, 9, and 26 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Allen* US Patent No. 6,785,891 (hereinafter "*Allen*"). Applicants respectfully traverse this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

In this case, *Allen* does not disclose "each and every element as set forth in the claim". For example, *Allen* does not disclose "automatically designating one of the at least two frames as a default search frame based on a pre-existing specification of the default search frame". The Examiner argues that *Allen* discloses "automatically designating one of the at least two frames as a default search frame based on a pre-existing specification of the default search frame" at Column 5, Lines 40-50. However, the cited passage is in fact directed to designating a visible frame as an active frame. See *Allen*, Col. 5, Lines 40-50. The cited section states that "one of the visible frames is designated as an active frame by default selection or user interaction". See *id.* *Allen* also states that "[t]he active frame is that frame which provides a response, if any, to a

user interaction. For example, if the active frame includes an HTML page having an applet that is being executed, a user interaction will be with that applet.” See *id.*

Accordingly, the section cited by the Examiner merely describes designating an active frame. See *id.* The cited section does not mention a default search frame. Indeed, *Allen* does not mention searching or a “search frame” at all. See *id.* Accordingly, the cited section does not describe “automatically designating one of the at least two frames as a default search frame based on a pre-existing specification of the default search frame”. Withdrawal of the objection is respectfully requested.

The Examiner also states that *Allen* describes “rendering the electronic document for display; wherein the designated default search frame of the displayed electronic document is available to a user for conducting a search of the searchable text contained in the designated default search frame and wherein, absent a command from the user to search a different one of the at least two frames, a user request to perform a search is, by default, automatically initiated in the designated default search frame”, citing *Allen* at Column 3, Lines 10-20. The cited section states that application environments can be HTML pages providing user interactivity within the context of the AS/400 Information Center. The cited section does not explicitly mention searching. However, the Examiner states that user interactivity per AS/400 inherently includes searching. The Examiner further states that US Pat. No. 6,801,906 (hereinafter *Bates* ‘906) at Column 5, Lines 40-45 discloses a search engine associated with AS/400.

Applicants submit that the Examiner errs in several respects. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). See *MPEP* Sec. 2112. To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). See *id.*

In the present case, Applicants first submit that *Allen*, the sole reference under which the claims are rejected, does not inherently describe that user interactivity per AS/400 inherently includes searching and that the Examiner has not met the burden of showing that the reference inherently describes the claimed subject matter. Also, with respect to the second reference cited by the Examiner, the Examiner has not provided a formal rejection of the claims under *Bates '906*. Furthermore, *Bates '906* merely refers to “an internet search engine”. Accordingly, the cited section of *Bates '906* merely describes a search engine for searching the internet. The cited section of *Bates '906* does not mention frames, nor does the cited section of *Bates '906* refer to searching for text in browser frames. Accordingly, the subject matter asserted by the Examiner is not inherent in *Allen*, the Examiner has not provided a proper rejection of the claims under *Bates '906*, and (even if the Examiner were to reject the claims with respect to *Bates '906*) the cited section of *Bates '906* does not teach the claimed subject matter and does not support the Examiner’s inherency argument. Accordingly, withdrawal of the rejection is respectfully requested.

Therefore, the claims are believed to be allowable, and allowance of the claims is respectfully requested.

Claim Rejections - 35 U.S.C. § 103

Claims 8 and 10-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Allen*. Applicants respectfully traverse this rejection.

First, with respect to each of the rejected claims, the claims are rejected on the basis of the Examiner’s arguments with respect to claims 1-7, 9, and 26. As described above, Applicants respectfully submit that the rejection of claims 1-7, 9, and 26 has been overcome. Accordingly, the rejection of Claims 8 and 10-25 is also believed to be overcome. Therefore, withdrawal of the rejection is respectfully requested.

Also, with respect to Claim 8, the Examiner concedes that, *Allen*, alone, fails to disclose “automatically designating comprises one of selecting from the at least two frames a frame containing a greater amount of content and selecting a largest frame from the at least two frames” as claimed. The Examiner goes on to state:

Official Notice is taken that automatically designating comprises one of selecting from the at least two frames containing a greater amount of content and selecting a largest frame from the at least two frames is well-known and expected in the art. It would have been obvious to one of ordinary skill in the art to modify Allen per the above limitation for the purpose of speeding up the process of searching.

See Office Action pp. 4.

With respect to Examiner's Official Notice, Applicants respectfully submit that it is not at all clear what facts of "common-knowledge" the Examiner is relying upon as required by MPEP § 2144 to support the Examiner's Official Notice. "Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known." MPEP § 2144.03 A. To properly reject the claims using facts of "common knowledge", the "Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge." MPEP § 2144.03, (citing *In re Soli*, 317 F.2d 941, 946 (CCPA 1963)). Applicants submit that "automatically designating [one of the at least two frames as a default search frame] comprises one of selecting from the at least two frames a frame containing a greater amount of content and selecting a largest frame from the at least two frames" is not "well known and expected in the art", and furthermore that the Examiner has failed to properly provide the "sound technical and scientific reasoning to support his or her conclusion of common knowledge". Accordingly, withdrawal of the rejection of Claim 8 is respectfully requested.

Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted, and
S-signed pursuant to 37 CFR 1.4,

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